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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
09/923,932	08/07/2001	Richard Emil Kajander	7144	3935

7590 12/26/2002

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EXAMINER
VO, HAI

ART UNIT	PAPER NUMBER
1771	

DATE MAILED: 12/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.	Applicant(s)
09 923,932	KAJANDER ET AL
Examiner	**Art Unit**
Hai Vo	1771

Office Action Summary

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-51* is/are pending in the application.

4a) Of the above claim(s) *1-15,27-40 and 52-56* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-26 and 41-51* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *07 August 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2*
4) ☐ Interview Summary (PTO-413) Paper No(s) _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1-15, 27-40, and 52-56, drawn to a method of making a foam coated nonwoven mat, classified in class 427, subclass various.

   II. Claims 16-26, and 41-51, drawn to a foam coated nonwoven mat, classified in class 442, subclass 76.

2. The inventions are distinct, each from the other because of the following reasons:

   Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as one that a foam is applied to a dried mat instead of the wet mat.

   Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

3. During a telephone conversation with Robert D. Touslee on 12/18/2002 a provisional election was made without traverse to prosecute the invention of Group II, claims 16-26, 41-46. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-15, 27-40, and 52-56 are withdrawn from further

consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Objections

4. Claims 16-26 and 41-51 are objected because they depend from non-elected claims.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 16-18, 20-22, 41, 42, and 45-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gill et al (US 4,681,798) in view of Potter et al (US 5,366,161). Gill teaches a composite material comprising a fibrous non-woven mat having an air permeability of 220 CFM/sq.ft and a coating of a foam material onto the top surface of the mat (abstract, example 3). Gill is silent as to a blow ratio, viscosity and an amount of the foam. Potter teaches a foam composition to treat pile fabrics having a blow ratio of 15 to 60 and a viscosity of 5 to 50000 centipoise (column 2, lines 40-44, column 5, lines 40-41). However, these variables would have been recognized by one skilled in the art to allow the foam to be processed and uniformly and completely to penetrate throughout the web. As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the foam having a blow ratio, viscosity and an amount instantly claimed since it has been held that where the

general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. ***In re Aller***, 105 USPQ 233. It is the examiner's position that the article of Gill as modified by Potter is only slightly different than the claimed article prepared by the method of the claim, because both articles use the same materials, having structural similarity (permeable fibrous mat having a foam coating on one face). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. ***In re Thorpe***, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. ***In re Marosi***, 218 USPQ 289,291 (Fed. Cir. 1983). The Gill and Potter references strongly suggest the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Gill as modified by Potter.

7. Claims 23-26 and 48-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gill et al (US 4,681,798) in view of Potter et al (US 5,366,161) and Randall (US 5,981,406). The combination of Gill and Potter teaches every element of the claimed

subject matter except the presence of the gypsum board. Randall teaches a composite material comprising a gypsum core and a fibrous mat adhered to one face of the core. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the gypsum core bonded to the foam coated fibrous mat of Gill as modified by Potter motivated by the desire to form a gypsum board effectively used in built-up roofing applications.

8. Claims 16-22, and 41-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Randall (US 5,981,406) in view of Potter et al (US 5,366,161). Randall teaches a composite material comprising a fibrous non-woven mat having an air permeability of 700 CFM/sq.ft and a coating of an expanded polystyrene foam material onto the top surface of the mat (column 9, lines 58-60, and column 10, lines 57-60). Randall is silent as to a blow ratio, viscosity and an amount of the foam. Potter teaches a foam composition to treat pile fabrics having a blow ratio of 15 to 60 and a viscosity of 5 to 50000 centipoise (column 2, lines 40-44, column 5, lines 40-41). However, these variables would have been recognized by one skilled in the art to allow the foam to be processed and uniformly and completely to penetrate throughout the web. As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the foam having a blow ratio, viscosity and an amount instantly claimed since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. ***In re Aller***, 105 USPQ 233.

It is the examiner's position that the article of Randall as modified by Potter is only slightly different than the claimed article prepared by the method of the claim, because both articles use the same materials, having structural similarity (permeable fibrous mat having a foam coating on one face). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. ***In re Thorpe***, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. ***In re Marosi***, 218 USPQ 289,291 (Fed. Cir. 1983). The Randall and Potter references strongly suggest the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Randall as modified by Potter.

9. Claims 16-22, and 41-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jaffee (US 6,008,147) in view of Potter et al (US 5,366,161). Jaffee teaches a composite material comprising a fibrous non-woven mat and a coating of a foam material onto the top surface of the mat (abstract). Jaffee is silent as to the air permeability of the foam coated mat. Since Jaffee is using the same materials such

as the same type of fibrous mat, binder and the foam material to form the laminate, it is the examiner's position that the air permeability of the mat would be inherently present.

Jaffee also is silent as to a blow ratio, viscosity and an amount of the foam. Potter teaches a foam composition to treat pile fabrics having a blow ratio of 15 to 60 and a viscosity of 5 to 50000 centipoise (column 2, lines 40-44, column 5, lines 40-41). However, these variables would have been recognized by one skilled in the art to allow the foam to be processed and uniformly and completely to penetrate throughout the web. As such, in the absence of unexpected results, it would have been obvious to one having ordinary skill in the art at the time the invention was made to employ the foam having a blow ratio, viscosity and an amount instantly claimed since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. ***In re Aller***, 105 USPQ 233.

It is the examiner's position that the article of Jaffee as modified by Potter is only slightly different than the claimed article prepared by the method of the claim, because both articles use the same materials, having structural similarity (permeable fibrous mat having a foam coating on one face). Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or an obvious from a product of the prior art, the claim is unpatentable even though

the prior product was made by a different process. ***In re Thorpe***, 227 USPQ 964, 966 (Fed. Cir. 1985). The burden has been shifted to the applicant to show unobvious differences between the claimed product and the prior art product. ***In re Marosi***, 218 USPQ 289,291 (Fed. Cir. 1983). The Jaffee and Potter references strongly suggest the claimed subject matter. It is noted that if the applicant intends to rely on Examples in the specification or in a submitted Declaration to show non-obviousness, the applicant should clearly state how the Examples of the present invention are commensurate in scope with the claims and how the Comparative Examples are commensurate in scope with Jaffee as modified by Potter.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hai Vo whose telephone number is (703) 605-4426. The examiner can normally be reached on Tue-Fri, 8:30-6:00 and on alternating Mondays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on (703) 308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

TERREL MORRIS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700

12/22/04